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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/786,216 | 02/25/2004 | Yuichi Yamato | Furuta Case 44 | 3043 |
| 23474 | 7590 | 07/17/2006 | EXAMINER | |
| FLYNN THIEL BOUTELL & TANIS, P.C. 2026 RAMBLING ROAD KALAMAZOO, MI 49008-1631 | | | CHANG, VICTOR S | |
| | | | ART UNIT | PAPER NUMBER |

1771

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/786,216

Applicant(s)

YAMATO ET AL.

Examiner

Victor S. Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7,8 and 10-14 is/are pending in the application.
- 4a) Of the above claim(s) 7,8 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Introduction

1. Applicants' amendments and remarks filed on 5/19/2006 have been entered. The abstract and specification have been amended. Claims 1-6 and 9 have been cancelled. Claims 7, 8, 10 and new claims 11-14 are active.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. In view of the complete rewrite of elected claims, the grounds of rejection have also been rewritten. However, the relied upon prior art references have not been changed.

Claim Objections

3. Because of the cancellation of claims 1-6, and the only independent claim is new claim 11, it is presumed that the parent claim for dependent claims 7 and 8 are new claim 11.

Additionally, the identifier for claims 7, 8 and 10 should be corrected as "(withdrawn)".

Appropriate correction is requested in the next reply.

Rejections Based on Prior Art

4. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zimmerman (US 2317662) in view of Itoh et al. (US 4201698), and evidenced by Kamiya (US 4061693).

Zimmerman's invention is directed to a cosmetic applicator of foam rubber (page 1, right column, lines 35-40).

For claims 11 and 12, Zimmerman is silent about a suitable rubber composition and the process and vulcanization chemistry. However, Itoh's invention relates to rubber compositions curable to rubbery elastomers by heating, in which an organic rubber, e.g. natural rubber or an organic synthetic rubber, such as butadiene-acrylonitrile rubbers (NBR), etc., and an organopolysiloxane rubber can be co-vulcanized (abstract; column 2, lines 59-67). The rubber composition prepared can be molded and vulcanized to form cured (crosslinked) rubbery elastomers, using conventional rubber processing techniques, such as extrusion molding, etc. (column 6, lines 44-47). Suitable curing agents include organic peroxides (column 6, lines 10-17). The amount of reinforcing siliceous filler is in the range of 5 to 200 parts by weight per 100 parts by weight of rubber component (column 6, lines 1-6), and, if necessary, in combination with other non-reinforcing or non-siliceous fillers, such as calcium carbonate, etc. (column 5, lines 63-68). In Table VI, Itoh shows examples of using about equal amount of calcium carbonate and siliceous fillers. It would have been an obvious selection to one of ordinary skill in the art to incorporate Itoh's process and vulcanization chemistry to make the foamed cosmetic applicator of Zimmerman. It should be noted that the selection of a known material based on its suitability for its intended use supported a prima facie obviousness determination. See MPEP § 2144.07. Regarding the term "a blowing agent", since Zimmerman teaches a foamed rubber, a blowing agent for forming the foamed rubber is inherently disclosed. Regarding the particle shape of the calcium carbonate, the Examiner notes that clearly Itoh's teaching is not limited to any particle shape, and encompasses the prismatic shape as claimed. Finally, the suitability of NBR (an acrylonitrile rubbers) for cosmetic use is evidenced by Kamiya's invention, in which

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Kamiya teaches that it is known that acrylonitrile resins have gain acceptance as receptacles for cosmetics (column 1, lines 8-11).

For claim 13, the nitrile group in NBR is inherently a polar group.

5. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zimmerman (US 2317662) in view of Itoh et al. (US 4201698) and Morrill (Rubber Technology, pages 304-309), and evidenced by Kamiya (US 4061693).

The teachings of Zimmerman and Itoh are again relied upon as set forth above.

For claim 14, Itoh is silent about the suitable range of acrylonitrile content in NBR. However, it is noted that Morrill teaches the NBR technology in general, and Morrill shows in Table 12.1 that various properties, such as oil resistance, hardness, resilience, etc., of NBR are related to acrylonitrile wt% in the copolymer. It would have been an obvious selection to one of ordinary skill in the art to select a suitable amount of acrylonitrile wt% in the NBR copolymer, motivated by the desire to obtain required physical properties for end application, such as oil resistance and resilience required for articles in contact with cosmetic products.

Response to Arguments

6. Applicants' remarks at pg. 5, last paragraph through pg. 6, first paragraph describes an invention that is not claimed (i.e., a formation method) and then concludes the applied references do not read thereon. Since these comments are not directed to the claimed invention of an applicator final product, Applicants' comments are unpersuasive for being non-commensurate. The manner in which the applicator is made is irrelevant to the patentability of the final product

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unless it can be shown that the method contributes materially to the structure and/or chemistry thereof.

Regarding Applicants' conclusion that one skilled in the art would not attempt to combine the teachings of the applied references, Applicants' assertion is unsupported and ignores the reasoning set forth by the Examiner in the grounds of rejection. There is no reason to believe that one skilled in the art would not recognize rubber can be foamed or that it is useful in that state. Applicants are attempting to analyze the disclosure in a vacuum and ignore the skill of the art.

Applicants' comparative evidence in the specification has been reviewed, but no comparison with the prior art applied is observed, nor does the examples cited evidence the difference in properties is unexpected, and further, the examples are not commensurate with the claims. The results are also subjective, not quantitative.

Finally, Applicants have made no argument to rebut the combined teachings of the relied upon prior references, nor why these references are not combinable. In response to Applicant's arguments, it is asserted that one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

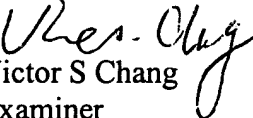
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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S. Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Victor S Chang
Examiner
Art Unit 1771


TERREL MORRIS
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